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OFFICE OF PETITIONS

In re Application :
Tang et al. :
Application No. 08/885,597 :
Filed: June 30, 1997 : DECISION ON APPLICATION
Atty Docket No. 06502.0023 : FOR PATENT TERM ADJUSTMENT

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705(b)" filed October 7, 2005. Applicants assert that the initial determination of patent term adjustment under 35 U.S.C. 154(b) of nine hundred seventy-five (975) days should be one thousand sixty-two (1062) days.

The application for patent term adjustment is GRANTED.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is one thousand sixty-two (1062) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On July 7, 2005, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above identified application. The Notice stated that the patent term adjustment (PTA) to date is nine hundred seventy-five (975) days. On October 7, 2005, Applicants timely¹ submitted an application for patent term adjustment, asserting that the patent term adjustment should be one thousand sixty-two (1062) days.

Applicants state that the application is not subject to a Terminal Disclaimer.

¹ Applicants paid the issue fee on October 7, 2005.

The Office initially determined a patent term adjustment of nine hundred seventy-five (975) days based on an adjustment for PTO delay of one thousand thirty-two (1032) days pursuant to 35 U.S.C. 154(b)(1)(C)(iii) and 37 C.F.R. § 1.703(e), reduced by applicants' delays of twenty-one (21) days pursuant to 35 U.S.C. 154(b)(2)(C)(ii) and 37 C.F.R. § 1.704(b) and thirty-six (36) days pursuant to 35 U.S.C. 154(b)(2)(C)(i) and 37 C.F.R. § 1.704(c)(8). Applicants' delay of 36 days has been reviewed and found to be correct. The adjustments of 1032 and 21 days are at issue.

The adjustment of 1032 days has been found to be incorrect. A review of the application file reveals that a Notice of Appeal was filed on June 28, 2001. A decision by the Board of Patent Appeals and Interferences, in favor of Applicants, was mailed on May 24, 2004, not April 24, 2004 as indicated in PAIR. 37 C.F.R. § 1.704(e) states that the period of adjustment is the number of days "beginning on the date on which a notice of appeal to the Board of Patent Appeals and Interferences was filed under 35 U.S.C. 134 and § 1.191 and ending on the date a final decision in favor of the Applicant by the Board of Patent Appeals and Interferences...." Accordingly, the PTO should have determined an adjustment of one thousand sixty-two (1062) days.

In addition, the adjustment of 21 days has been found to be incorrect. The Office mailed a final Office action on March 7, 2001. On March 28, 2001, the Office mailed a non-final Office action, withdrawing the finality of the prior Office action. On June 28, 2001, Applicants timely filed a Notice of Appeal, and were erroneously assessed 21 days of applicant delay. Applicant delay with respect to this filing should have been zero (0) days.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is **one thousand twenty-six (1026) days** (1062 days of PTO delay, reduced by 36 days of applicant delay), subject to any terminal disclaimer.

Receipt of the \$200.00 fee set forth in 37 C.F.R. § 1.18(e) is acknowledged.

The application file is being forwarded to the Office of Patent Publication for processing into a patent.

Telephone inquiries specific to this matter should be directed to Cliff Congo, Petitions Attorney, at (571)272-3207.

Kery A. Fries

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